

The opinion in support of the decision being entered today
is not binding precedent of the Board.

Paper No. ⁴52

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

AUG 20 2002

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS

ANDREW S. KATOCs, JR., ELWOOD LARGIS AND SOTIRIOS K. KARATHANAS²

Junior Party¹,

v.

RONALD M. EVANS, DAVID J. MANGELSDORF, RICHARD A. HEYMAN,
MARCUS F. BOEHM, GREGOR EICHELE AND CHRISTINA THALER

Senior Party²

Patent Interference No. 103,931

DECISION ON JOINT SUPPLEMENTAL PRELIMINARY MOTION UNDER
37 CFR § 1.633(c)

A jointly-filed Preliminary Motion to redefine the interference pursuant to 37 CFR
§ 1.633(c) (Paper No. 38) was denied (see DECISION ON JOINT PRELIMINARY

¹ Application 07/860,814, filed March 31, 1992, now US 5,219,888. Assignors to American Cyanamid Company.

² Application 08/482,737, filed June 7, 1995. Accorded the benefit of application 08/244,857, filed June 14, 1994, 08/809,980, filed December 18, 1991, now abandoned, and PCT US92/11214, filed December

MOTION UNDER 37 CFR § 1.633(c) TO REDEFINE THE INTERFERENCE AND CONCESSIONS OF PRIORITY, Paper No. 45) because

(1) no motion under 37 CFR § 1.633(h) had been filed to add Katocs reissue application 09/176,003 to this interference and therefore undersigned was not in a position to consider the motion to designate Katocs reissue claim 1 to correspond to a proposed Count A as requested, and,

(2) undersigned was not satisfied that the parties had met their burden under 37 CFR § 1.633(c) to "[s]how that each proposed count defines a separate patentable invention from every other count proposed to remain in the interference" (37 CFR § 1.637(c)(1)(v)), in accordance with the test set forth in 37 CFR § 1.601(n).

Undersigned permitted the parties to file a preliminary motion under 37 CFR § 1.633(h) as well as a supplemental preliminary motion under 37 CFR § 1.633(c) to address the issues raised in the Decision.

In response, the parties filed the following papers:

1. "Katocs Preliminary Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)" which seeks a grant to add U.S. Reissue Application No. 09/176,003, filed October 21, 1998, to this interference³ (Paper No. 51);
2. "Katocs Preliminary Motion for Benefit of the Filing Date of an Earlier Filed

18, 1992. Assignors to The Salk Institute for Biological Studies, Baylor College of Medicine, and Ligand Pharmaceuticals, Inc.

³ Although the motion is entitled "... Motion to Substitute a Different Application Pursuant to 37 CFR § 1.633(h)," to be accurate, Katocs is in fact seeking to add the reissue application to the interference. 37 CFR § 1.633(h) permits a party to file a preliminary motion "to add [an] application for reissue to the interference," and, at the end of the motion, Katocs clearly states that "Junior Party Katocs et al. move to have the '333 [reissue] application added to this interference under 37 CFR § 1.633(h)."

Application Pursuant to 37 CFR §1.633(f)" (Paper No. 50) which seeks a grant to accord the reissue application benefit of the March 31, 1992 filing date of interfering U.S. Patent 5,219,888, now surrendered; and,

3. "Joint Supplemental Preliminary Motion Pursuant to 37 CFR § 1.633(c)" (Paper No. 48).

As to the Katocs Preliminary Motions filed under 37 CFR §§ 1.633(h) and (f), they have not been opposed and are GRANTED. Accordingly, U.S. Reissue Application No. 09/176,003, filed October 21, 1998, is added to the interference and accorded the benefit of the March 31, 1992 filing date of U.S. Patent 5,219,888.

As to the Joint Supplemental Preliminary Motion filed under 37 CFR § 1.633(c), undersigned has carefully reviewed it and is satisfied that the parties have addressed the concerns raised in the prior Decision (Paper No. 45). Undersigned now finds that, for the reasons discussed in the parties' supplemental motion, the parties have "[s]how[n] that each proposed count defines a separate patentable invention from every other count proposed to remain in the interference" (37 CFR § 1.637(c)(1)(v)), in accordance with the test set forth in 37 CFR § 1.601(n). The motion is GRANTED.

Concomitant with the granting of the Joint Supplemental Preliminary Motion filed under 37 CFR § 1.633(c) to redefine the interference, the following motions are also GRANTED:

- joint preliminary motion (Paper No. 38, p. 2) pursuant to 37 CFR § 1.633(c)(1) to redefine the interference by substituting Count 1 with proposed Counts A and B;
- joint preliminary motion (Paper No. 38, p. 2) pursuant to 37 CFR § 1.633(c)(2) to redefine the interference by designating:
 - claim 1 of Katocs Reissue Application No. 09/176,003 to correspond to proposed Count A;

- claim 1 of Katocs U.S. Patent 5,219,888 to correspond to proposed Counts A and B; and,
- claim 30 of Evans' Application 08/482,737 to correspond to Proposed Count B.

As a result of the granting of these motions, the interference is hereby
redeclared (see attached REDECLARATION OF INTERFERENCE) to reflect the
following:

Counts	Subject Matter	Claim of Senior Party Evans' Application 08/482,737 Designated To Correspond to Count	Claim of Junior Party Katocs Patent 5,219,888 Designated to Correspond to Count	Claim of Junior Party Katocs Reissue Application 09/176,003 Designated to Correspond to Count
A ⁴	all-trans- retinoic acid		claim 1 ⁵	claim 1 ⁶

⁴ Count A reads as follows:

A method to modulate lipid metabolism in a subject, said method comprising administering to said subject an effective amount of all trans-retinoic acid, or pharmaceutically acceptable carrier containing same;

or

A method of increasing plasma HDL levels in a mammal which comprises administering all trans-retinoic acid in a pharmacologic amount effective to increase said plasma HDL levels.

⁵ 1. A method of increasing plasma HDL levels in a mammal which comprises administering a pharmacologic amount effective to increase said plasma HDL levels of a compound selected from the group consisting of the retinoids all trans-retinoic acid, and 9-cis-retinoic acid.

⁶ Claim 1 (the only claim) of reissue application 09/176,003 reads as follows:

A method of increasing plasma HDL levels in a mammal which comprises administering all-trans-retinoic acid in a pharmacologic amount effective to increase said plasma HDL levels.

B ⁷	9-cis-retinoic acid	claim 30 ⁸	claim 1	
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Undersigned points out that, pursuant to 35 USC § 135(c) and 37 CFR § 1.666 "in contemplation of the termination of the above captioned interference" (Paper No. 30, p. 2), the parties have filed an executed settlement agreement with the Board (see Paper No. 30; see also discussion on p. 2 of Paper No. 36). Based on the settlement agreement, Evans concedes priority to Katocs under 37 CFR § 1.662(a) of the subject matter of Count A directed to administering an effective amount of all-trans-retinoic acid to either modulate lipid metabolism in a subject or increase plasma HDL levels in a mammal (Paper No. 39), and Katocs concedes priority to Evans under 37 CFR § 1.662(a) of the subject matter of Count B directed to administering an effective amount of 9-cis-retinoic acid to either modulate lipid metabolism in a subject or increase plasma HDL levels in a mammal (Paper No. 40).

The settlement agreement has been made subject to Katocs filing a reissue application amending claim 1 of Katocs '888 patent such that it is directed to increasing

⁷ Count B reads as follows:

A method to modulate lipid metabolism in a subject, said method comprising administering to said subject an effective amount of 9-cis-retinoic acid, or pharmaceutically acceptable carrier containing same;

or

A method of increasing plasma HDL levels in a mammal which comprises administering 9-cis-retinoic acid in a pharmacologic amount effective to increase said plasma HDL levels.

⁸ 30. A method to modulate lipid metabolism in a subject, said method comprising administering to said subject an effective amount of 9-cis-retinoic acid, or pharmaceutically acceptable carrier containing same.

plasma HDL levels using only all-trans-retinoic acid.⁹ That contingency has been met: Katocs filed application 09/176,003¹⁰ for reissue of Katocs patent '888 on October 12, 1998, with patent claim 1 amended as agreed to by the parties. The settlement agreement (see Paper No. 36, p. 2) was also accompanied by a joint preliminary motion to redefine the interference consistent with the agreed concessions of priority. Given the granting, supra, of the Joint Supplemental Preliminary Motion filed under 37 CFR §1.633(c), and the consequent Redeclaration of the Interference (see attached paper), the parties have received the requested relief underlying the settlement agreement.

There are no other issues remaining in this interference. This interference is now in a condition for rendering judgment.



Hubert C. Lorin
Administrative Patent Judge

⁹ See paper no. 36: "As discussed, Katocs has a patent claim that corresponds to Count 1 and claims both species of Count 1. Thus, in order for the Board to grant the motion to redefine the count and to enter the concessions of priority, Katocs must file a reissue application that separately claims the two species of Count 1 that are set forth in Katocs patent claim."

¹⁰ The declaration in the reissue application states that "Interference No. 103,931 was declared between U.S. Patent No. 5,219,888 and U.S. Serial No. 08/482,737 and following an exchange of proof, priority to the use of 9-cis retinoic acid was conceded by Katocs (U.S. Patent 5,219,888)."

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